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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/045,151	01/15/2002	Robert C. Lehr	100201014-1	8861
22879 7590 12/10/2009 HEWLETT-PACKARD COMPANY Intellectual Property Administration 3404 E. Harmony Road Mail Stop 35 FORT COLLINS, CO 80528			EXAMINER FISHER, MICHAEL J	
			ART UNIT 3689	PAPER NUMBER
			NOTIFICATION DATE 12/10/2009	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/045,151

Applicant(s)

LEHR ET AL.

Examiner

MICHAEL J. FISHER

Art Unit

3689

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/CD)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4,8-12,16,18-25,27,28,32,35,37-41,44,45,,47,48 and 50-54 are rejected under 35 U.S.C. 102(b) as being anticipated by US PAT 5,745,884 to Carnegie et al. (Carnegie).

As to claims 1,18,19, 27,37,45, Carnegie discloses a hardware pay per use system (title) comprising one or more hardware products (col 4, lines 53-56), a metering agent that acquires metric data (306,316, as best seen in fig 3), and a usage repository that generates reports on the received data (308, 318).

As to claim 20, as the user is charged for usage, the "data to report" would be usage (metrics data" and the "usage report" (bill) would be based on this.

As to claim 53, the device would be at the central server and therefore would not be at the device, a processor controls the operation (fig 1).

As to claims 2,39, the system generates and sends bills (308,318).

As to claims 3,21,40,50,51, the usage reports are visible and available to the client as they are included in the bills, the invoice is presented (bill), payment is expected and therefore, it would be inherent that it can be received.

As to claims 4,48, Carnegie discloses a validation server (fig 3, it validates the data in that it checks to see who should be billed), a usage database (where the account info is and to which is added billing data, 308,318), it would inherently ensure that the hardware is correctly configured else it could not use the network.

As to claim 8,28,44,52 the hardware devices collect the metric data that is also acquired by the metering device (claim 5), it would inherently use software to do so.

As to claims 9,22,39, there are rules to be used to determine the data (fig 3).

As to claims 10,38, the system polls the hardware to determine to acquire metrics data (to check if the user has an account).

As to claims 11,41, the data is provided on a periodic basis (claim 7).

As to claims 12, a CPU is used (fig 1).

As to claims 16,35, the metering mechanism and usage repository are not at the same site as the device.

As to claims 22, the usage reports are based on applying rules (fig 3).

As to claims 23, it would be inherent that the usage reports are compared to pricing schemes as the pricing schemes affect the billing.

As to claims 24, it would be inherent that the rate is affected by the plan.

As to claims 25, as the rules are used by a business, they would inherently be "business" rules.

As to claims 32,48, the operating data is verified (to ensure that the user has an account), verifying an approved configuration (fig 3) that would inherently be saved, saving the operating data (316).

As to claim 47, as the hardware is connected to the Internet, it would inherently be on a "digital site".

As to claim 54, Carnegie discloses encrypted, compressed data (219,222, as best seen in fig 2).

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 5-7, 13-15,26, 29-31,33,34,36,42,43,46,49 and 55-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carnegie.

As to claims 5-7, the actual make-up of the various components would not make the invention patentably distinct as these are all well-known computer variations and it would be obvious to use them as Carnegie uses computers.

As to claim 13, Carnegie does not, however, teach leasing the equipment. However, it is old and well known in the art to lease equipment. Therefore, it would have been obvious to one of ordinary skill in the art to lease the equipment to ensure that

your customers could have the necessary equipment with a minimum of investment on their part.

As to claims 14,33, the location of the devices would not make the invention patentably distinct as they are merely a matter of obvious design choice.

As to claims 15,34,36, Carnegie discloses using the Internet (fig 1), therefore, it would have been obvious to one of ordinary skill in the art to use the Internet to ease retrieval of information.

As to claim 26, it would be obvious to report a peak utilization to better study the program to ensure its smooth operation.

As to claim 29, it would be obvious to bill the entity leasing the hardware as they are responsible for it.

As to claim 30, the lessee would enquire about getting service with the company.

As to claim 31, the usage reports are visible and available to the client as they are included in the bills, the invoice is presented (bill), payment is expected and therefore, it would be inherent that it can be received.

As to claim 42, the periodic rate would be considered a matter of obvious design choice and would not make the invention patentably distinct.

As to claim 43, it would be obvious to check the configuration is the same so as to ensure that it is the correct user using the system and not a so-called "hacker".

As to claim 46, where the products are installed is considered to be a matter of obvious design choice and would not make the invention patentably distinct.

As to claim 49, Carnegie does not specifically teach that the acquiring means is a stand-alone computer. This would be a matter of obvious design choice, as it is merely another variation on the computer taught by Carnegie, and would not make the invention patentably distinct.

As to claim 55, it would have been obvious to test transport means to ensure that the customer is billed properly.

As to claim 56, the system uses email (col 9, lines 1-6).

As to claim 57, it would be obvious to test the device to ensure that it has not received a virus.

As to claim 58, the known response would prove that the user has an account (fig 3).

As to claim 59, it would have been obvious to one of ordinary skill in the art to use the metering engine to check the known response as the metering agent is used in setting charges.

As to claim 60, the device uses the Internet (fig 1).

As to claim 61, the Internet is a digital, data, communications network.

Response to Arguments

Applicant's arguments with respect to rejection under 35 U.S.C. 102(b) using "so-called Ma Bell" have been fully considered and are persuasive. The rejection has been withdrawn. The examiner will note that this rejection was re-inserted in an effort to show

that the claims, as currently amended, are so broad that they could be met merely by charging for long distance on a telephone line.

Applicant's arguments filed 8/13/09 have been fully considered but they are not persuasive. As to arguments in relation to Carnegie, the examiner agrees, the prior art teaches charging users for using a computer service, it is based on "metrics". As to arguments in relation to "provided on a periodic basis", billing is periodic and not "as-called". Further, "as-called" is "periodic", there is no requirement that the "period" be the same.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL J. FISHER whose telephone number is (571)272-6804. The examiner can normally be reached on Mon.-Fri. 7:30am-5:00pm alt Fri. off.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MF

12/5/09

/Janice A. Mooneyham/

Supervisory Patent Examiner, Art Unit 3689